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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,220

03/18/2005

Mark C. Tevis

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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

12/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,220	Applicant(s) TEVIS ET AL.	
	Examiner Elena Tsoy Lightfoot	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-37, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

1. Amendment filed on October 29, 2009 has been entered. Claim 38 has been cancelled. Claims 24-37, 39, and 40 are pending in the application. Claim 24 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Claims examined on the merits are 25-37, 39, and 40.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Rejection of claims 25-39 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling has been withdrawn due to amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-35, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekioka et al (US 6899752) in view of Kubota et al (US 5698284), further in view of Uematsu (JP07-073511A), and further in view of Danelski (US 5282917).

Sekioka et al in view of Kubota et al in view of Uematsu is applied here for the same reasons as set forth in paragraphs 5 and 9 of the Office Action mailed on 7/29/2009.

As to applying an image ink to the outer surface of the second layer, Sekioka et al teaches that "latent image" refers to numerals, letters, color tones, patterns, symbols, marks, bar codes, etc. which cannot be seen by the naked eye under ordinary conditions and are recorded onto sheets such as **paper currency, stock certificates, insurance certificates, ID cards and documents**, cards made of wood, plastic, metal, IC chips or the like, as well as other types of articles, and particularly a durable ink composition which allows accurate reading for detection and deciphering of data (latent image data) recorded as such invisible marks (latent images), as well as printed objects such as sheets, cards and articles bearing latent images produced with the latent image ink composition printed on substrates, and a method and device for deciphering latent image data on such substrates and discriminating their genuineness based on the latent images (See column 2, lines 20-41). Sekioka et al also teaches that the method may be effectively utilized for discriminating the genuineness of various tickets or cards used by **stadiums, game centers** (See column 9, lines 51-53).

Note that paper currency, stock certificates, insurance certificates, ID cards and documents *always* have **visible images** in addition to "latent images". Obviously visible images should not overlap "latent images" for detection of possible fraud.

Sekioka et al in view of Kubota et al fails to teach that visible image is provided either on the first protective layer or on the second protective layer.

Danielski teaches in the BACKGROUND OF THE INVENTION that promotional devices such as advertising sheets, wagering games such as lottery tickets, and novelty products

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such as greeting cards all desirably utilize a gimmick or technique to attract and maintain the interest of the prospective reader or user. A standard but still effective gimmick is the use of a concealed message including **light-sensitive hidden** messages (which are visible only under light of a particular wavelength), water-activated hidden messages (which are visible when the message is moistened with water), glow-in-the-dark hidden messages (which are visible only in darkness and after initial exposure to light), and **rub-off lottery tickets** (wherein the winning number or symbol is initially concealed by an opaque coating and revealed only when the coating is scratched or rubbed off, as with an eraser or coin), and the like (See column 1, lines 20-35). In other words, Danielski teaches that visible images could be printed on rub-off and *non-rub-off* tickets. Danelski further teaches that game tickets or cards are generally provided with visible image by lithographically printing with UV curable ink (See column 6, lines 58-59) in addition to concealed images (See column 1, lines 20-59); and the visible image is covered **by a transparent film** (See column 2, lines 20-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a visible image with UV curable ink on a second layer of three-layer protective film of Sekioka et al in view of Kubota et al such that the visible would be protected with a protective film.

Applicant's arguments

Applicants submit that the cited references, either alone or in any proper combination, fail to teach or suggest applying an image ink to the outer surface of the second layer to produce an image as required by amended independent claims 25 and 40. For instance, Sekioka et al. describes an ink composition that is not visible to the naked eye and that is used to create a so-called latent image. Such ink composition is formed, in part, with a curing resin composition that forms a protective film over the hidden image. Col. 2, lines 61-65; Col. 8, lines 5-10. Importantly, the protective film "must be hard and tough, water-resistant, fouling resistant and scratch resistant, and capable of... permitting reliable discrimination of the latent image." Col. 8,

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lines 5-10. in other words, the purpose of the protective film is to prevent anything from concealing the ink composition. Such a film teaches away from the presently pending claims in that the claims now require applying an ink to an outer surface of the claimed first or second layer. The description of Sekioka et al. expressly teaches away from such a modification in that an ink composition is already present underneath the protective film and used to form a latent image. Furthermore, the description makes it clear that the protective film is designed to prevent obstructions from blocking the covered ink composition. As such, it is respectfully submitted that the claims patentably define over Sekioka et al. in any proper combination. For example, in the previous Office Action, Sekioka et al. was combined with Danielski in an attempt to render obvious then pending dependent claim 38, the limitation from which the amendment to claim 25 was made. The Office Action stated that because "Danielski teaches that game tickets or cards are generally provided with visible image by lithographically printing with UV curable ink...in addition to concealed images...it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a visible image on a second layer." Page 1 I, July 29, 2009 Office Action. However, as stated above, Sekioka et al. teaches away from applying an ink to the outer surface of the product described therein. Furthermore, Danielski only describes printing onto a removable film to expose a concealed image. As described in Danielski, "[r]emoval of the film from the inked surface portion also removes the ink in one of the selected patterns to reveal a desired pattern of deinked outer surface and thereby render visible the previously concealed message." In other words, the ink is only present on the outer surface because the outer surface is removable to reveal a concealed message. Such a configuration is the complete opposite of the configuration described in Sekioka et al. As such, it is respectfully submitted that the presently pending claims patentably define over the cited references.

The Examiner respectfully disagrees with this argument. Note that paper currency, stock certificates, insurance certificates, ID cards and documents *always* have **visible images** in addition to "latent images". Obviously visible images should not overlap "latent images" for detection of possible fraud. Danielski teaches that visible images could be printed on rub-off and non-rub-off tickets. Danielski further teaches that game tickets or cards are generally provided with visible image by lithographically printing with UV curable ink (See column 6, lines 58-59) in addition to concealed images (See column 1, lines 20-59); and the visible image is covered by **a transparent film** (See column 2, lines 20-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a visible image with UV curable ink on a second layer of three-layer protective film of Sekioka et al in view of Kubota et al such that the visible would be protected with a protective film.

6. Claims 25-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekioka et al '752 in view of Kubota et al '284, further in view of Maag et al (US 6472026),

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further in view of Uematsu '511, and further in view of Danelski '917 for the reasons discussed above and for the reasons of record set forth in paragraph 6 of the Office Action mailed on 7/29/2009.

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Sekioka et al '752, Kubota et al '284, Uematsu '511 and Danelski '917 or over a combination of Sekioka et al '752, Kubota et al '284, Maag et al '026Uematsu '511 and Danelski '917, as applied above, and , further in view of Brack (US 4303696) for the reasons of record set forth in paragraphs 7 and 9 of the Office Action mailed on 7/29/2009.

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Sekioka et al '752, Kubota et al '284, Uematsu '511 and Danelski '917 or over a combination of Sekioka et al '752, Kubota et al '284, Maag et al '026Uematsu '511 and Danelski '917, as applied above, and further in view of Ishikawa et al (US 5795642) for the reasons of record set forth in paragraphs 8 and 9 of the Office Action mailed on 7/29/2009.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

December 2, 2009

/Elena Tsoy Lightfoot/